REMARKS/ARGUMENTS

Applicants would like to thank Examiner Cain for the helpful and courteous discussions he had with Applicants' U.S. representative on March 22, 2005. At that time, Applicants' U.S. representative argued that the process as claimed in Claims 2 and 3 is not inherent over the cited reference (Lerman, U.S. 3,449,291). In addition, Applicants argued that the claimed thermally fusible resin of Claim 8 is not obvious over Lerman. The following is intended to expand upon that discussion.

The presently claimed process involves a method for producing a colored fine particulate resin where the resin is a polyester resin having aromatic or alicyclic rings or an epoxy resin having aromatic rings or alicyclic rings. The presently claimed process is not taught or suggested by the cited reference.

Lerman describes a process for preparing colored finely-divided thermoplastic resins. The process involves heating the resin in water with an ethylene oxide/propylene oxide surfactant to form the finely-divided resin. Lerman exemplifies only polyethyene as a possible thermoplastic resin. In fact, Lerman only generically lists non-olefin resins such as cellulosics and polyesters in the specification. Notably, Lerman does not suggest or teach the use of a specific polyester resin having aromatic rings or alicyclic rings. In addition, Lerman does not suggest or teach the use of any kind of epoxy resins.

The size of the thermopolymer or polyester genus described in Lerman is so large, there is simply no motivation or suggestion to select the polyester or epoxy resin species as presently claimed. The express teachings of Lerman would lead one skilled in the art to select species of polyolefins not specific species of any other types of resin. The number

of variables which must be selected or modified, and the nature and significance of the differences between Lerman and the claimed process are too great for one skilled in the art to select the presently claimed species. See, e.g., in *Re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992).

Because Lerman does not teach or suggest all the claim limitations of the presently claimed process and because Lerman provides no reasonable motivation to select the claimed species, the claimed process is not anticipated or obvious over the cited reference. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections based on Lerman.

Finally, Applicants note that the claimed melt viscosity (Claims 2 and 3) is not inherent over Lerman. Lerman describes a melt index for a polyethylene polymer. In contrast, the presently claimed process involves a melt viscosity for a polyester or epoxy resin. Because the reference and presently claimed process utilize two different viscosity measurements on two different polymer types, inherently cannot be reasonably established. In addition, Lerman provides no details as to how the melt index was measured. Melt index values depend upon pressure and temperature and Lerman fails to provide these details. As a result, the melt index values cannot be reproduced. Because inherency may not be established by possibilities or probabilities, applicants submit that the Examiner has not established that the claimed melt viscosity values are inherent over Lerman. Therefore, Applicants respectfully request that the Examiner withdraw the rejection based on inherency.

In light of the above remarks contained herein, Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Donald K. Drummond, Ph.D.
Registration No. 52,834

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
DKD/rac:aps